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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/039,855

10/19/2001

John K. Billock

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7590

08/10/2006

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EXAMINER

SHANG, ANNAN Q

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/039,855	BILLOCK ET AL.	
	Examiner	Art Unit	
	Annan Q. Shang	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's amendment and arguments filed 05/19/06 have been fully considered but they are not persuasive.

With respect to claims 1-16, 19-25, 30, 31 and 36-38, rejected under 103(a) as being unpatentable over **Garfinkle (5,530,754)** in view of **Callais et al (3,790,700)**, applicant amendments claim 1 discusses the disclosure of Garfinkle and Callais and argues that Garfinkle in view of Callais do not teach the claimed limitations and are not rendered obvious from the combination (see page labeled 14+ of applicant's Remarks).

In responses, Examiner disagrees. Examiner notes applicant's arguments, however as admitted by applicant, Garfinkle teaches a VOD system in which catalog data of available video product listings, trailers, previews, etc., are transmitted to subscribers and non-subscribers to enable the subscribers and non-subscribers to interact to order VOD as desired (fig.2, col.3, lines 6-49 and col.4, line 35-col.5, line 22), as claimed. Garfinkle is silent to distinguishing between subscribers and non-subscribers. However in the same field of endeavor, Callais teaches CATV program control system (col.3, lines 55-66), which provides subscribers previews of subscription TV program and further teaches Headend 13, which provides services to groups of subscribers by comparing a list of subscribers and their groups, lawyers, Doctors or other groups of subscribers sharing a common interest, restricting programs to only those selected groups of persons and if a request is receive from persons not identified in a specific group, restricts or prevents such groups or persons from receiving the

programs (col.5, lines 4-18 and line 48-col.6, line 22), which meets the deficiency not disclosed in Garfinkle. Furthermore the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. All references are in the same field of endeavor, i.e., a head end or CATV broadcasting system, as such combining the teaching of Garfinkle in view of Callais, and the various 103(a) rejection of their dependent claims, would have be within the knowledge of one of ordinary skill in the art.

Hence, Examiner maintains the 103(a) rejection of Garfinkle in view of Callais and the various 103(a) rejection their dependent claims, is proper, meet all the claimed limitation and maintained as discussed below. **This Office Action is made Final.**

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-16, 19-25, 30-31 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Garfinkle (5,530,754)** in view of **Callais et al (3,790,700)**.

As to claims 1-3, note the Garfinkle reference figures 1-4, discloses a method of operating a video-on-demand service (VOD services provider Central Station 'CS' 10 or

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Telecasting facility, col.2, lines 39-47) comprising at least one interactive channel (Data link 16, col.2, lines 58-67) coupled to a viewing station (User Site 'U-Site' 18), the service accessible to subscribers and non-subscribers of the service, the service providing video programs, segments of the video programs, and a list of at least some of the video programs, the method comprising:

Transmitting (Central Station or Telecasting facility 'CS' 10, col.2, line 39-col.3, line 5) first signal (Catalog data, menu, preview video products, types of products, by category 'classification information,' etc., fig.2, col.3, lines 32-49 and col.4, 50-58) to the viewing station (U-site 18, which is coupled to CS-10 via Data link 16, col.2, line 58-col.3, line 26) acknowledging access of the service (Video product, e.g., educational, movie, etc.); transmitting the list (Catalog data and Menu) to the viewing station (col.3, lines 6-49 and col.4, line 35-col.5, line 22);

Receiving (CS-10) a second signal (user interactive requests) from the viewing station indicating a selection of one of the segments of the video programs (col.3, lines 26-62), note that the user, via an input device (col.3, lines 50-54) interacts to Menu 50, which includes preview video products or trailers, to order any available video product;

Transmitting (CS-10) one of the segments (lead-in or Initial segment) to the viewing station indicating one of the segments to the viewing station when the second signal indicates a selection of the one segment (col.3, line 50-col.4, line 22);

Transmitting (CS-10) one of the video programs (Movie) to the viewing station when the second signal indicates a selection of the video program by one of the subscribers (col.3, line 66-col.4, line 12 and line 35-col.5, line 22), note that the CS-10

uses the appropriate identification data of the desired product along with a U-Site identifier to billing each user or subscriber accordingly.

Garfinkle fails to explicitly teaches preventing transmission of one of the video programs to the viewing station when the second signal indicates a selection of one video program by one of the non-subscribers.

However, note the **Callais** reference figure 1, discloses CATV program control system (col.3, lines 55-66), which provides subscribers previews of subscription TV program and further teaches Headend 13, which provides services to groups of subscribers by comparing a list of subscribers and their groups, lawyers, Doctors or other groups of subscribers sharing a common interest, restricting programs to only those selected groups of persons and if a request is receive from persons not identified in a specific group, restricts or prevents such groups or persons from receiving the programs (col.5, lines 4-18 and line 48-col.6, line 22).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Callais into the system of Garfinkle to provider a headend that advertises products/services to users, but only provides services to previously authorized subscribers and prevents transmission of video programs to non-subscribers, in order to force non-subscribers to subscribe to TV programs before receiving services.

As to claim 4-6, Garfinkie further discloses where the video programs and the segments comprise video and audio portions, at least one movie and one TV program (col.3, lines 32-49 and col.4, lines 13-46).

As to claim 7, the claimed "A video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

As to claims 8-9 Garfinkie further discloses where the communication medium is coaxial cable and fiber optic cable and comprises a plurality of channels (col.2, lines 58-67).

As to claim 10, the claimed "A video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

Garfinkie fails to explicitly teach displaying on a display an offer for the non-subscribers to become a subscriber substantially immediately after the non-subscriber selects on of the video programs for display and receiving and acceptance of the offer to be a subscriber, establishing non-subscriber as a subscriber substantially immediately after the receiving and allowing the video programs selected by the non-subscriber to be displayed on the display substantially immediately after the establishing.

However, note the **Callais** reference figure 1, discloses CATV program control system (col.3, lines 55-66), which provides subscribers previews of subscription TV program and further teaches where if Headend 13, finds the terminal address of the subscriber on its restricted authorized viewer list for that a type of program, it will transmit downstream to the subscriber terminal a video enable command which will allow the Subscriber to receive the restricted program (col.6, lines 4-36).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Callais into the system of Garfinkle to provide offers to non-subscribers thereby forcing non-subscribers, to subscribe to TV programs before receiving services to generate income.

As to claims 11-13, Garfinkie further discloses a TV monitor, which provides audio and also a personal computer (col.2, line 58-col.3, line 22).

As to claim 14, the claimed "A video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

Claim 15 is met as previously discussed with respect to claim 10.

As to claim 16, the claimed "A method of operating a video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

As to claims 19-20, the claimed "A method of operating a video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

As to claim 21, the claimed "A video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3; the claimed "a second computer couple to the display..." is met by user input device (col.3, lines 50-66).

As to claim 22, Garfinkie further discloses the preview comprises a portion of a corresponding video program (col.3, lines 26-49 and col.4, lines 13-58).

As to claims 23-24, Garfinkie further discloses preview comprises a summary of the content of the corresponding video program and audio (col.3, lines 26-49 and col.4, lines 13-58).

As to claim 25, Garfinkie further discloses where the summary comprises full-motion video (col.3, lines 26-49 and col.4, lines 13-58).

As to claim 30-31, Garfinkie further discloses where the telecasting facility is further operative to transmit textual descriptions of the video programs, the User display is further operative to receive the textual descriptions and the interactive interface comprises a list mode actuator that when actuated causes one of the lists to be displayed on the display, preview mode actuator that when actuated causes one of the previews to be displayed on the display and information mode actuator that when actuated causes one of the textual descriptions to be displayed on the display and a remote control unit (col.3, line 35-col.4, line 34 and lines 50-58).

As to claims 36-38, the claimed "A method of operating a video-on-demand service comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3

4. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Garfinkle (5,530,754)** in view of **Callais et al (3,790,700)** as applied to claim 16 above, and further in view of **West et al (5,550,575)**

As to claims 17 and 18, Garfinkle as modified by Callais, fail to explicitly teach where the classification information causes the video programs that contain violence to be excluded from the generated list and generating a list for children.

However, note the **West** reference figures 1-4, teaches a parental control interface which excludes programs containing violence and provides list of children programs (col.11, line 52-col.12, line 39 and col.14, lines 17+).

Therefore it would have been obvious to one of the ordinary skill in the art at the time of the invention to incorporate the teaching of West into the system of Garfinkle as modified by Callais to enable a parent to control TV programs to a child can watch.

5. Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Garfinkle (5,530,754)** in view of **Callais et al (3,790,700)** as applied to claim 21 above, and further in view of **Linnett et al (5,682,469)**

As to claims 26-29, Garfinkle as modified by Callais, fail to explicitly teach where a plurality of windows for textual, previews, etc.

However, note the **Linnett** reference figure 7, disclose user interface comprises various windows for displaying text, video and other graphics (col.3, lines 10-40 and col.7, line 6-55).

Therefore it would have been obvious to one of the ordinary skill in the art at the time of the invention to incorporate the teaching of Linnet into the system of Garfinkle as modified by Callais to enhanced the user interface with various windows to enable the user to interact to each window as desired to retrieve related information.

6. Claims 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Garfinkle (5,530,754)** in view of **Callais et al (3,790,700)** as applied to claim 21 above, and further in view of **Vogel (5,253,066)**

As to claims 32-35, Garfinkle as modified by Callais, fail to explicitly teach a display which allows a user to scroll through a menu in different directions.

However, note the **Vogel** reference figures 1, 3 and 4, disclose user interface which allows a user to scroll through a menu in different direction in an endless loop using a Remote Control (col.3, lines 24-45, col.4, lines 40-51 and col.5, lines 13-38).

Therefore it would have been obvious to one of the ordinary skill in the art at the time of the invention to incorporate the teaching of Vogel into the system of Garfinkle as modified by Callais to enhanced the user interface with arrows that enables the user to scroll in other direction as desired to retrieve information.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**.



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